

Amendment dated: October 13, 2004

Application Serial No.: 10/662,327

Attorney Docket No. 093833-0311906 (27688-003)

In Response to Office Action mailed May 13, 2004

### **REMARKS**

In response to the First Office Action mailed May 13, 2004, claims 17-26 have been newly added. No claims have been cancelled or amended. Therefore, claims 8-9 and 17-26 are pending. Support for newly added claims 17-26 is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

### **Drawings & Specification**

The Examiner has objected to the drawings for allegedly failing to comply with 37 C.F.R. §1.84(p)(5), because FIG. 3 includes reference characters "106c" and "106d" not mentioned in the description. *See* 5/13/04 Office Action, pg. 2. Applicants have amended the Specification at pg. 6, line 10 (second full paragraph),<sup>1</sup> to include a recitation of reference characters "106c" and "106d."

Applicants submit that the changes to the Specification described above do not constitute the addition of new matter, as support for the instant amendments is provided in FIG. 3 as-filed. Accordingly, Applicants respectfully request that the Examiner approve the changes to the Specification.

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<sup>1</sup> This paragraph was previously amended in a Preliminary Amendment submitted March 24, 2004. *See* 3/24/2004 Preliminary Amendment at pg. 5.

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**Rejections Under 35 U.S.C. §102**

Claim 8 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,050,695 to Fromm. *See* 5/13/04 Office Action, pg. 2. Applicants traverse this rejection for *at least* the reason that Fromm neither explicitly nor impliedly discloses each of the elements of claim 8.

Claim 8 recites, *inter alia*, the feature of “*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be linked together.*” Fromm fails to disclose this claim element.

In particular, Fromm appears to teach a single pair of jewelry items [*e.g.*, first jewelry item (10) and second jewelry item (12)], wherein operation of an electrical display associated with at least one of the jewelry items is initiated by bringing the two jewelry items together. As illustrated in FIGS. 2-3 of Fromm, for instance, one of the jewelry items is provided with two male contacts (28, 30) while the other is provided with two corresponding female contacts (36, 38). When the male contacts (28, 30) are properly inserted into female contacts (36, 38), a circuit is completed activating a light source (18) in each of the jewelry items.

Fromm, however, does not disclose enabling multiple jewelry items from different pairs of jewelry items to be linked together, and even appears to teach away from doing so:

Because, in the preferred embodiment, the male and female contacts have *specific cross-sections suitable for each other, only matching finger rings can be used together* to close the normally open circuits, causing the two finger rings to become illuminated.

*See* Fromm, col. 3, lines 20-24, ***Emphasis added.***

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Moreover, Applicants note that when the single pair of jewelry items of Fromm are brought into operational contact with one another (*e.g.*, FIGS. 4, 7, 8, 10), the male and female contacts are connected leaving the individual jewelry items with no apparent, remaining exposed contacts or other components to enable them to be linked to other jewelry items. For *at least* these reasons, Fromm fails to disclose the feature of enabling multiple jewelry items from different pairs of jewelry items to be linked together.

Claim 8 also recites the feature “*wherein each of the first and second friendship objects is personalized by an audible message.*” While Fromm generally discloses (at col. 4, lines 3-8) that a device (54) may be provided which emits sound, Fromm does not appear to disclose that the sound emitted from device (54) may be personalized.

For *at least* each of the foregoing reasons, the rejection of claim 8 is improper and should be withdrawn.

### **Rejections Under 35 U.S.C. §103**

Claim 9 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Fromm in view of U.S. Patent No. 6,618,328 to Ellner *et al.* (“Ellner”). See 5/13/04 Office Action, pg. 3. Applicants traverse this rejection for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the

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claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

Applicants submit that there exists no teaching, suggestion, or motivation to modify Fromm to include the teachings of Ellner. In particular, Ellner is directed toward a time-keeping apparatus (*e.g.*, a watch) and is non-analogous to the novelty jewelry disclosed by Fromm. Assuming arguendo that Ellner and Fromm were not deemed to be non-analogous, and that there was a proper teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Fromm and Ellner, even when combined, fail to disclose, teach or suggest all of the claim elements.

Specifically, the addition of Ellner does not cure the deficiencies in the disclosure of Fromm articulated in detail above concerning Fromm's failure to disclose the feature of enabling multiple jewelry items from different pairs of jewelry items to be linked together. Accordingly, the rejection of claim 9 is improper and should be withdrawn.

**Newly Added Claims 17-26**

Applicants submit that newly added dependent claims 17-26 are allowable because they depend from allowable independent claims, as well as for the further limitations they contain.

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**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

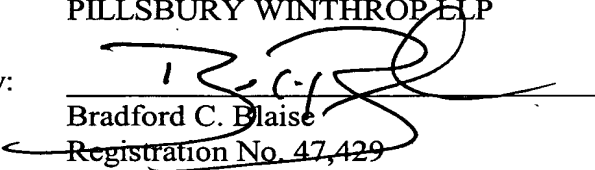
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: October 13, 2004

Respectfully submitted,

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